Remarks

This Amendment responds to an Office Action in the above-listed matter, mailed 9 June 2009. This Amendment is being filed with a one-month extension of time, and the requisite fees associated therewith. This Amendment does not increase the number of independent claims above three. However, this Amendment does increase the total number of claims by five (5). Accordingly, this Amendment is being filed with the requisite fees for five (5) additional claims.

This Amendment is accompanied by Revocation of Power of Attorney With New Power of Attorney forms executed by both of the inventors. The Examiner is respectfully requested to verify that the USPTO records are updated to reflect the new correspondence address associated with the new Powers of Attorney.

For the Claims:

Claims 1-24 are pending in this application. This Office Action rejected claims 1-24. Applicant amends claims 1, 4, 5, 7-15, and 20-23, adds claims 25-29, and retains claims 2, 3, 6, 16-19, and 24 as originally or previously submitted. Applicants respectfully request reconsideration in view of the modifications to the claims and the following remarks.

This Office Action rejects claims 1-24 under 35 U.S.C. 102(b) as being anticipated by Weiss, U.S. Publication No. 2002/0174031. Claims 1, 4, 5, 7-15, and 20-23 have been amended and claims 25-29 have been added to more clearly point out Applicants' invention, to correct minor inconsistencies in terminology, and to define an abbreviation. No new matter has been introduced into the application as a result of the present Amendment.

Arguments

The only document cited in the Office Action was Weiss.
Weiss teaches of a system and method for processing multi-
currency transactions at a point-of-sale (POS). The Weiss
technique determines whether a transaction is in a locally
processed currency or a non-locally processed currency and
proceeds according to the determination. Weiss uses a multi-
currency payment platform which uses software to interface a POS
terminal with a voucher receiving module. The software gives the
POS terminal the capability to recalculate a transaction amount
from the locally processed currency into the non-locally
processed currency, and allows the cardholder to decide in which
currency the transaction will be processed. In addition, the
merchant can receive settlement in the currency of his choice,
which may not necessarily be the locally processed currency
(Abstract).

Independent Claim 1

Weiss does not disclose a method for effecting the
performance of a payment card transaction for a first transaction
amount between a first merchant and a first cardholder, as
recited in claim 1. In particular, Weiss does not disclose the
features of creating a first payment card transaction record,
creating a second payment card transaction record, and submitting
the first and second transaction card records for processing as
payment card transactions, with the specific functionality as
recited in claim 1. Rather, Weiss teaches away from the claimed
features.

Amended claim 1 includes the features of in response to
initiation of the payment card transaction between the first
merchant and the first cardholder, creating a first payment card
transaction record between the first merchant and a second
cardholder for the first transaction amount in a first currency,
and in response to the initiation of the payment card transaction
between the first merchant and the first cardholder, creating a
second payment card transaction record between a second merchant
and the first cardholder, wherein the second transaction record
identifies a second transaction amount in a second currency which
equates to the first transaction amount converted into the second
currency. The first and second transaction records are submitted
for processing as respective first and second payment card
transactions, such that processing the first record credits the
first merchant and processing the second record debits the first
cardholder.

Thus, the invention of amended claim 1 creates two distinct
payment card transaction records upon initiation of a single
payment card transaction between a first merchant and first
cardholder, and each of these two distinct payment card
transaction records is in a different currency. These two
distinct payment card transaction records are between different
entities, i.e., the first record is between the first merchant
and a second cardholder and the second record is between a second
merchant and the first cardholder. Moreover, these two distinct
payment card transaction records are submitted as two distinct
payment card transactions for payment processing.

The Office Action indicates that Weiss at paragraph [0049]
discloses the claim 1 limitation of creating a first payment card
transaction record between the first merchant and a second
cardholder for the first transaction amount. The Weiss
disclosure at paragraph [0049] pertains to a transaction process

for locally processed currency, i.e., the merchant's local currency. In accordance with paragraph [0049], when a cardholder first pays a merchant using a payment card (i.e., engages in a transaction) the merchant forwards a voucher to a voucher receiving module via the merchant's POS terminal for authorization of the transaction. The voucher receiving module handles the routing of the authorization request and logs the transaction and its authorization status in a database server.

The Office Action does not point out how paragraph [0049] relates to the feature of creating a first payment card transaction record, as recited in claim 1. Rather, the Office Action only includes reference to [0049] without explaining its relevance to the claimed subject matter. Consequently, Applicants are compelled to speculate as to which element in paragraph [0049] relates to creating a first payment card transaction record, as recited in claim 1.

In this instance, one might speculate that the Weiss voucher is somehow equivalent to the claimed first transaction record. However, such speculation is erroneous because, given that the voucher is forwarded from the merchant to the voucher module site, the merchant presumably creates the voucher. Since the merchant creates the voucher, and the merchant is engaged in a transaction with the cardholder, the voucher as a payment card transaction record must be between the merchant and the cardholder and not between the merchant and a second cardholder as claimed.

Alternatively, one might speculate that the Weiss teaching of the voucher receiving module logging a transaction and its authorization status in a database server is somehow equivalent to creating the first payment card transaction record. However, the data logged in a database, if considered a payment card

transaction record, still must be between the merchant and the cardholder and not between the merchant and a <u>second cardholder</u> as claimed. Thus, the cited paragraph [0049] fails to teach or suggest anything resembling "in response to initiation of the payment card transaction between the first merchant and the first cardholder, creating a first payment card transaction record <u>between the first merchant and a second cardholder</u> for the first transaction amount in a first currency."

The Office Action further indicates that Weiss at paragraph [0067] discloses the claim 1 limitation of creating a second payment card transaction record between a second merchant and the first cardholder, wherein the second transaction record identifies a second transaction amount in a second currency which equates to the first transaction amount converted into the second currency. The Weiss disclosure at paragraph [0067] pertains to a multi-currency transaction in which a cardholder selects a currency other than the local currency. Such a selection prompts the POS terminal to communicate with the voucher receiving module to obtain the current exchange rate between two different currencies.

Again, the Office Action does not point out how paragraph [0067] relates to the feature of creating a second payment card transaction record, as recited in claim 1. Rather, the Office Action only includes reference to [0067] without explaining its relevance to the claimed subject matter. Consequently, Applicants are again compelled to speculate as to which element in paragraph [0067] relates to creating a second payment card transaction record, as recited in claim 1.

In contrast to the Weiss disclosure of paragraph [0049], paragraph [0067] provides no disclosure of creating a voucher (if a voucher is somehow considered a second payment card transaction

record). Likewise paragraph [0067] provides no disclosure of
logging data into a hypothetical database server (if the logged
data is somehow considered a second payment card transaction
record). Thus, paragraph [0067] is silent as to the subject
matter of "in response to the initiation of the payment card
transaction between the first merchant and the first cardholder,
creating a second payment card transaction record between a
second merchant and the first cardholder...," as recited in claim
1.

Perhaps one might dissociate the creating operations of claim
1 into separate transactions between different
merchant/cardholder pairs. Such a scenario could entail a)
creating a first payment card transaction record between a first
merchant and a second cardholder engaged in, for example, the
locally processed currency transaction of paragraph [0049] and b)
creating a second payment card transaction record between a
second merchant and a first cardholder engaged in, for example,
the multi-currency transaction of paragraph [0067]. Perhaps one
could further speculate that the second transaction amount
identified in the second payment card transaction record may
equate to the first transaction amount in the first transaction
record, only in different (first and second) currencies per claim
1. Such speculation is unreasonable, especially when the claim
is interpreted in light of the specification.

Nevertheless, if one were to use this line of reasoning as a
basis for rejecting claim 1, it should be abundantly clear that
the modifications to each of the creating operations to add the
limitation of "in response to initiation of the payment card
transaction between the first cardholder and the first merchant"
explicitly ties the creation of two distinct payment card
transaction records to the single payment card transaction
between the first merchant and the first cardholder. Moreover,

when all the limitations of the creating operations are fully
considered, it should also be clear that Weiss fails to teach or
suggest creating two distinct payment card transaction records in
response to initiation of the payment card transaction between
the first cardholder and the first merchant, as recited in claim
1.

Weiss fails to teach or suggest the creating operations of
independent claim 1 for reasons set forth above. It follows,
therefore, that Weiss fails to teach or suggest submitting the
first and second transaction records for processing as payment
card transactions, as recited in claim 1, whereby processing the
first record credits the first merchant and processing the second
record debits the first cardholder.

Weiss discloses a process of receiving payments on authorized
charges at paragraph [0069] and illustrated in FIG. 2d. The
Weiss payment process entails submission of authorized vouchers
by the merchant to the acquirer. The acquirer forwards the
vouchers to the issuer through the local or multi-currency
processor and the clearinghouse. The clearinghouse sends the
payment to the acquirer which then forwards the payment to the
merchant or merchant's bank. The forwarding of an authorized
voucher from the merchant and sending back payment to the
merchant indicates that a single voucher (if considered a payment
card transaction record) per payment card transaction between the
merchant and a cardholder is implemented in the Weiss system.
This contrasts with the submitting operation of claim 1 in which
the first transaction record (between the first merchant and a
second cardholder) and the second transaction record (between a
second merchant and the first cardholder) are submitted for
processing as respective first and second payment card
transactions. The express recitation of "first and second" as
well as the plural nomenclature "transactions" clearly and

expressly distinguishes the distinct payment card transactions related to the first and second payment card transaction records created in response to a single payment card transaction between the first merchant and the first cardholder.

Nor is it obvious to modify the Weiss system to create first and second payment card transaction records between differing entities (i.e., between first merchant and second cardholder and between second merchant and first cardholder) in response to a payment card transaction between a first merchant and a first cardholder to more closely resemble Applicants' invention of claim 1. As stated in In re Gordon et al., 221 USPQ 1125 at 1127 (Fed. Cir. 1984) and repeated in In re Laskowski, 10 USPQ 1397 at 1398 (Fed. Cir. 1989):

> The mere fact that the prior art could be so modified
> would not have made the modification obvious unless the
> prior art suggested the desirability of the modification.

Accordingly, the proper evaluation for determining patentability is to consider whether the prior art suggests the desirability of modifications which make the Weiss multi-currency transaction processing methodology more closely resemble Applicants' creating and submitting features of claim 1. Moreover, this suggestion must be found in the prior art and not Applicants' specification.

Applicants' specification discusses the problems to be surmounted in implementing multi-currency transactions. These problems include that of suitably amalgamating normal and dynamic currency conversion transactions without introducing duplication debits against the cardholder (paragraph [0009]) and without necessitating a significant and costly amount of software to be re-written at acquirer banks' host computer systems in order to implement dynamic currency conversion services (paragraphs

[0010], [0011], and [0013]). Applicants solve these problems, at least in part, by effectively replacing the first cardholder (engaged in a payment card transaction with a first merchant) with a second cardholder in the first payment card transaction record and by specifying a second merchant in lieu of the first merchant in the second payment card transaction record. Therefore, the subsequent processing of the second payment card transaction record will not cause a duplicated debit to the first cardholder (paragraphs [0018] and [0069]). Accordingly, the necessity of re-writing an acquirer's software, and its related cost, to avoid any such duplicate debit is avoided. Nor do acquirer systems have to be amended to introduce, cater to, and/or receive "ghost copy" transactions for the purposes of amalgamation and/or for calculating service charges for the merchant.

Weiss suffers from the problems Applicants' invention as defined in claim 1 solves. That is, the Weiss multi-currency transaction process requires complicated and costly additional system components and code, in the form of at least the voucher receiving module, the database system, and so forth which are used to process and store data regarding transactions. Weiss expressly discloses that the voucher receiving module is of at least two types. One type of voucher receiving module is an acquirer module associated with and usually physically located at a particular acquirer (paragraph [0051]). Another type of voucher receiving module is a delegated module that interfaces between multiple acquirers and their merchants in a particular geographical territory (paragraph [0056]). These teachings serve to further emphasize the specialized system components and code necessitated by the Weiss multi-currency transaction methodology.

The specialized voucher receiving module and database system such as that described by Weiss is undesirably complex and costly

since it requires significant additional code to implement the voucher receiving module and database system as well as code to enable interaction between the voucher receiving module and conventional acquirer processes.

Weiss fails to suggest the desirability of modifications which would make the Weiss multi-currency transaction methodology more closely resemble Applicants' invention of claim 1 because Weiss arrived at a different solution for supporting multi-currency transactions, namely that of a specialized voucher receiving module and database system. Accordingly, although Weiss provides a system for supporting multi-currency transactions, an individual reading the Weiss document would be led in a direction divergent from that which is claimed. However, the Weiss system suffers from a number of problems that the invention of claim 1 solves. Since Weiss suffers from problems that Applicants' invention solves, Weiss cannot suggest their solution. Therefore, any suggestion for modifying Weiss to more closely resemble Applicants' invention of claim 1 can only be found through hindsight gained by understanding Applicants' specification and claims. Of course, it is improper to use hindsight in making an obviousness rejection.

In the absence of explanation in the Office Action, Applicants have not been given fair opportunity to respond to any clearly and specifically stated objections to patentability of claim 1 based on Weiss. Rather, Applicants were compelled to speculate as to the relevance of paragraphs cited in the Weiss document to the claimed invention. Nevertheless, for the reasons set forth above, Applicants believe that Weiss fails to teach or suggest the invention of claim 1. Accordingly, Applicants contend that claim 1 is indeed novel and inventive over Weiss.

Independent Claim 12

Claim 12 was amended along lines similar to the modifications to claim 1. In addition, claim 12 was amended to improve its clarity and readability.

The Office Action rejects claim 12 in parallel with the rejection of claim 1. As such, the Office Action fails to point out any disclosure in the Weiss document that might fairly be a teaching of the system of claim 12 which includes, among other features, (a) means for receiving details of the payment card transaction <u>between a first merchant and a first cardholder</u>, the details including a first transaction amount, (b) means for creating a first payment card transaction record <u>between the first merchant and a second cardholder</u> for the first transaction amount in a <u>first currency</u> in response to the received details, and (c) means for creating a second payment card transaction record <u>between a second merchant and the first cardholder</u> in response to the received details, where the second transaction record identifies a second transaction amount in a <u>second currency</u>.

In the absence of explanation in the Office Action, Applicants have not been given fair opportunity to respond to any clearly and specifically stated objections to patentability of claim 12 based on Weiss. Rather, as discussed above in connection with claim 1, Applicants are compelled to speculate as to the relevance of paragraphs cited in the Weiss document to the claimed invention. Nevertheless, for the reasons set forth above, Applicants believe that Weiss fails to teach or suggest the invention of claim 12 for reasons similar to those set forth in connection with claim 1. Accordingly, Applicants contend that claim 12 is novel and inventive over Weiss.

Dependent Claims 2-11 and 13-26

Claims 2-11, 24, and new claims 25 and 26 depend directly or indirectly from claim 1. Thus, claims 2-11 and 24-26 are believed to be allowable at least by reason of dependency. Claims 13-23 depend directly or indirectly from claim 12. Thus, claims 13-23 are also believed to be allowable at least by reason of dependency.

Claims 4, 5, 15, and 16

Claim 4 includes subject matter directed toward creating, in response to the initiation of the payment card transaction between the first merchant and the first cardholder, a third payment card transaction record between the second cardholder and the second merchant for an amount in the first currency, the amount being the negative equivalent of the first transaction amount and submitting the third payment card transaction record for payment processing. Similarly, claim 15 includes subject matter directed toward means for creating, in response to receiving the details of the payment card transaction, a third payment card transaction record between the second cardholder and the second merchant for an amount in the first currency, the amount being the negative equivalent of the first transaction amount, and means for submitting the third payment card transaction record for payment processing. Claims 5 and 16 depend respectively from claims 4 and 15 and include subject matter directed toward the third payment card transaction record being submitted as an unconverted payment card transaction. Applicants respectfully contend that the further features of claims 4, 5, 15, and 16 are not disclosed by Weiss, despite Office Action allegations to the contrary.

The Office Action indicates that Weiss at paragraph [0016]
discloses the limitations of claims 4, 5, 15, and 16. The Weiss
disclosure at paragraph [0016] pertains to enabling cardholders
to expedite reporting of their expenses based on actual
transaction amounts. The cited paragraph provides an example in
which a business person traveling abroad is able to receive
receipts in the business person's currency of choice in order to
expedite his ability to reconcile and submit expense reports.
The cited paragraph also provides another example in which a
cardholder could choose to pay in a different currency based on
other considerations such as favorable exchange rates so as to
optimize the economics of the purchase.

The Office Action does not point out how paragraph [0016]
relates to the feature of creating a third payment card
transaction record, as recited in claims 4 and 15. Rather, the
Office Action only includes reference to [0016] without
explaining its relevance to the claimed subject matter.
Applicants have not been given fair opportunity to respond to any
clearly and specifically stated objections to patentability of
claims 4, 5, 15, and 16 based on Weiss. Consequently, Applicants
are again compelled to speculate as to which element in paragraph
[0016] relates to the features of claims 4, 5, 15, and 16.
However, in this instance, Applicants cannot find any teaching in
the cited passage that could be relevant to the subject matter of
claims 4, 5, 15, and 15.

It bears repeating, however, that Weiss fails to teach or
suggest anything resembling creating the first and second payment
card transaction records as discussed above in connection with
claim 1. That is, Weiss, fails to teach or suggest a second
cardholder, and a first payment card transaction record being
created between the merchant and the second cardholder.

Likewise, Weiss fails to teach or suggest a second merchant, and a second payment card transaction record being created between the second merchant and the first cardholder. It follows, therefore, that if Weiss does not teach a second merchant and a second cardholder, Weiss simply cannot teach or suggest creating a third payment card transaction record between two non-existent entities <u>in response to the payment card transaction between the first cardholder and the first merchant</u>.

Further, it would not have been apparent to the skilled person to implement changes to Weiss to arrive at a solution closer to the subject matter presented in claims 4, 5, 15, and 16. The present invention, as recited in claims 4, 5, 15, and 16, offers an approach to effectively perform a transfer between an intermediary's merchant account (e.g., the claimed second merchant) and an intermediary's cardholder account (e.g., the claimed second cardholder) by creating a third payment card transaction record between the second cardholder and the second merchant (paragraph [0072]). This third payment card transaction record can be effectively processed as a conventional payment card transaction between the second cardholder and the second merchant. However, the net result of this transaction via the third payment card transaction record is to effectively debit from the cardholder and credit to the merchant the transaction amount. Weiss teaches away from the present solution by providing an alternative means of supporting multi-currency transactions.

Applicant therefore submits that for these reasons as well, the invention of claims 4, 5, 15, and 16 is novel and inventive over Weiss.

Claim 8

Amended claim 8 includes subject matter directed toward creating a merchant additional revenue card transaction record between the second or a related cardholder and the first merchant, wherein the merchant additional revenue card transaction record identifies a transaction amount which equates to additional revenue to be settled to the first merchant in response to using dynamic currency conversion to engage in the payment card transaction with the first cardholder.

The Office Action indicates that Weiss at paragraph [0015] discloses the limitations of claim 8. The Weiss disclosure at paragraph [0015] states an object of the Weiss invention. This object is to facilitate a transaction in which a cardholder will see an amount on his/her billing statement that corresponds to the exact amount processed at the time of transaction in the currency of the cardholder's choice and for which the cardholder received a bill or receipt from the merchant. The Weiss disclosure at paragraph [0015] further states that the cardholder will not bear the cost of exchange rate differentials and other costs associated with the translation of currencies, other than what the cardholder signed for, or otherwise assented to, at the time of purchase.

The Office Action does not point out how paragraph [0015] relates to the subject matter recited in claim 8. Rather, the Office Action only includes reference to [0015] without explaining its relevance to the claimed subject matter. Nor can Applicant ascertain a relationship between the disclosure of Weiss and the subject matter of claim 8.

Paragraph [0015] of Weiss cited by the Office Action as an alleged anticipatory teaching of claim 8 is silent as to the

subject matter of claim 8. Still further, Applicants have carefully reviewed the remainder of the Weiss document and can find no teaching of creating a merchant additional revenue card transaction record that identifies a transaction amount which equates to additional revenue to be settled to the first merchant in response to using dynamic currency conversion to engage in the payment card transaction with the first cardholder, as recited in claim 8. At best, any teaching of profiting from multi-currency transactions (i.e., earning any kind of "additional revenue") can be found in Weiss at paragraph [0052] in which an acquirer pays the merchant for the vouchers usually at some discounted rate so as to permit the acquirer to profit from the transaction. This teaching is clearly unrelated to creating a merchant additional revenue card transaction record that identifies additional revenue to be settled to the first merchant in response to using dynamic currency conversion to engage in the payment card transaction with the first cardholder. Rather, the additional revenue is debited from the merchant and settled to the acquirer so that the acquirer profits from the transaction.

Since Weiss is absent any teaching or suggestion of the features of claim 8, Applicants therefore submit that Weiss cannot anticipate claim 8. Therefore, the invention of claim 8 is novel and inventive over Weiss.

Claims 25 and 26

Claim 25 was added to point out that the first currency is a merchant currency and the second currency is a cardholder currency. Claim 26 was added to point out that the received details include the first transaction amount in the cardholder currency. Claims 25 and 26 were added to more clearly point out the multiple transaction record methodology utilizing multiple

currencies. No new matter is being added, and claims 25 and 26 are believed to be novel and inventive over Weiss for at least the reasons set forth above in connection with claim 1.

Claims 27-29

Claims 27-29 were added to more clearly point out the multiple transaction record methodology of the present invention. The subject matter of claims 27-29 is presented in Applicants' specification at paragraphs [0061] through [0072]. No new matter is being added. Claims 27-29 are believed to be novel and inventive over Weiss for at least the reasons set forth above in connection with claims 1 and 8.

Conclusion

As discussed above, the Weiss technique requires a specialized voucher receiving platform and database system for supporting multi-currency transactions. The Weiss methodology teaches away from the present solution by providing an alternative means of supporting multi-currency transactions than that which is claimed.
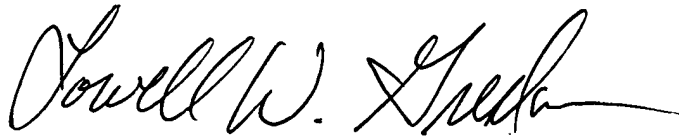
Furthermore, although the Office Action cited various paragraphs in the Weiss document as alleged anticipatory teachings of certain claims, the Office Action did not explain their relevance to the claimed subject matter. Consequently, Applicants were compelled to speculate as to the relevance of the cited passages to the claimed subject matter. Thus, Applicants were not given fair opportunity to respond to any clearly and specifically stated objections to patentability of the claims based on Weiss.

Applicants respectfully request the Examiner to fully consider all claim limitations within each of the rejected claims and provide clear and specific information for establishing a prior art basis for rejecting the claims. If a prior art basis for rejection cannot be articulated, Applicants respectfully request withdrawal of the rejection of claims 1-24 under the provisions of §102(b) based on Weiss, and a subsequent allowance of claims 1-24 and new claims 25-29.

Accordingly, this Amendment cancels amends claims 1, 4, 5, 7-15, and 20-23, and adds claims 25-27. Currently amended claims 1, 4, 5, 7-15, and 20-23 remain in the application and are believed to be allowable and newly added claims 25-29 are believed to be allowable. In addition, claims 2, 3, 6, 16-19, and 24 remain in the application as originally or previously submitted and are believed to be allowable.

Applicants believe that the foregoing amendments and remarks are fully responsive to the rejections and/or objections recited in the 9 June 2009 Office Action and that the present application is now in a condition for allowance. Accordingly, reconsideration of the present application is respectfully requested.

Respectfully submitted,

Lowell W. Gresham
Attorney for Applicants
Reg. No. 31,165

Lowell W. Gresham
5727 North Seventh Street
Suite 409
Phoenix, AZ 85014
(602) 274-6996